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EXAMINER

CHRISTMAN, KATHLEEN M

ART UNIT PAPER NUMBER

3713

DATE MAILED: 08/31/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/806,983

Applicant(s)

BAJER ET AL.

Examiner

Kathleen M Christman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03/23/2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-55 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-55 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

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DETAILED ACTION

In response to the preliminary amendment filed 03/23/2004, claims 1-55 are pending.

Priority

Applicant is requested to update the status of the application(s) relied upon for priority in the first line of the specification.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requires of this title.

1. Claims 17-24 and 32-43 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Regarding claims 17 and 32, the preamble of the claims set forth "a system for providing a computer implemented training session". However, each of the elements of the claim is directed "logic". The term logic has two art-accepted definitions. The first refers to traditional transistor type logic components, such as AND, and NAND gates, PLC etc. The second refers to the assertion, assumptions, and operations that define what a program does. Although the first may constitute a statutory embodiment the second does not. The second results in the claiming of a computer program per se. As the program is not embodied on any tangible medium it does not fall into a statutory category and thus is not eligible for patent protection. Claims 33-37 depend on claim 32 and do not correct this deficiency. As such they are rejected for the same reason.

Regarding claims 38-43, the preamble of the claim recites "an interface". An interface is commonly known as software, which enables a user to interact with a computer. Given this definition the claims are directed to a computer program per se. As the software is not embodied on any type of

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tangible medium the structure is drawn to non-statutory subject matter and is not eligible for patent protection. See MPEP §2106.

Regarding claims 18-24, for a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts. The claimed method does not apply, involve, use, or advance the technological arts. The recited steps of merely presenting information to a user, obtaining reactions (responses) from the user, recording the reactions and presenting more information (a second portion of the stimulus, feedback) to the user does not apply, involve, use, or advance the technological arts since all of the recited steps can be performed in the mind of the user or by use of a pencil and paper. These steps only constitute an idea of how to train a user to identify an assumption. Although the preamble recites "computer implemented" the mere intended or nominal use of a component, albeit within the technological arts, does not confer statutory subject matter to an otherwise abstract idea if the component does not apply, involve, use, or advance the underlying process.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1, 9 and 17 recite the limitation "wherein the computer implemented training session shows the

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user to validate assumptions". This limitation is unclear. This limitation has been grouped with the step of outputting feedback to the user, but does not appear to actually be related to the feedback. The claims themselves are directed to a method, system and computer readable medium for providing the computer implemented training session. It appears that applicant is claiming the intended functionality of the claims, but it is unclear how this limitation relates to the other limitations in the claims. The examiner has interpreted this recitation to be the intended outcome of the claimed method and system.

3. Claims 25-31 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential structural cooperative relationships of elements, such omission amounting to a gap between the necessary structural connections. See MPEP § 2172.01. The applicant has not clearly shown the relationship between the code segments and the computer readable medium. The preamble recites "A computer program embodied on a computer readable medium for providing a computer implemented training session for ... the training session comprising:". The claim has been written in a manner that refers to the training session comprising the code segments, and thus does not show the structural limitations of the computer program. It is not clear how the training session can comprise these elements. For purposes of examination the examiner has interpreted the code segments as belonging to the computer program, not the training session.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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4. Claims 1 and 9 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 19 and 20 of U.S. Patent No. 6,736,642. Although the conflicting claims are not identical, they are not patentably distinct from each other because there is only a minor difference in the claims. The claims of the instant invention are broader than the claims of the patent. The patent recites that the simulation includes a police call regarding a situation and the stimuli include images of at least one person in the situation, and that the responses include questions for the person in order to collect evidence pertinent to the situation. These recitations represent a specific embodiment of the more general simulation and responses of the instant invention. One could not use the patented invention without infringing on the more generic claims of the instant invention. Further, the specific type of information conveyed in an educational simulation is a matter of design choice as one of ordinary skill in the art may easily modify the content of an educational program to fit the needs of the person to be trained.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-3, 6, 8-11, 14, 16 and 17 are rejected under 35 U.S.C. 102(b) as being anticipated by Kerwin (US 5616033). Regarding claims 1, 9 and 17, Kerwin teaches an educational system, method and computer based media in which the user is presented a stimuli in a simulation, is prompted to enter a response to the stimuli, the prompt being automatic (claims 3 and 11), (answering a multiple

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choose question), receives the response, allows the user to enter an assumption that forms that basis for the response and ways to validate the assumption (the user enters a narrative response), receives the information, and produces feedback to the user. Regarding **claims 2 and 10**, the simulation in Kerwin is typically displayed as a text simulation. The use of a multiple-choice question demonstrates the user selecting a response from a listing of a plurality of responses, as in **claims 6 and 14**. In regard to **claims 8 and 16**, as there is no limit to the number of assumption, or sentences that the Kerwin narrative response can include the feedback produced from this is based upon the number of assumptions entered.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. **Claims 4, 5, 12 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kerwin (US 5616033) in view of Sallette (US 6155840).** Kerwin does not explicitly teach the use of a transcript (claims 4 and 12) or the display of the assumption and how to validate the assumptions being displayed (claims 5 and 13). Sallette teaches computer based training system in which there is a window

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for displaying presentation text and transcripts of the training system, see Figure 7 and presentation and notes section shown in Figure 6. As both inventions are drawn to computer based education systems it would have been obvious to one of ordinary skill in the art to combine the teachings of Kerwin with those of Sallette in order to allow a user to review the information from earlier in the session.

7. **Claims 7 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kerwin in view of Ramshaw et al (US 5791907).** The Kerwin patent does not explicitly show that ability for a user to access a knowledge database. Ramshaw et al teaches the ability for a user to access a database of information in Figure 3A. As both inventions are drawn to computer based educational systems it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the educational system of Kerwin with the databases as taught by Ramshaw et al so as to allow a user to further investigate a topic.

8. **Claims 38-55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sallette (US 6155840) in view of Mortimer et al (US 6091930).** Sallette discloses an apparatus, method of use, and computer readable medium storing instruction for an interface for a computer teaching system. Regarding **claims 38, 44, and 50** of the instant application and referring to figure 6 of Sallette, there is a navigation bar, a frame for displaying a video presentation, a text box for displaying questions relating to the presentation, and a second frame containing a transcript of the presentation possibly including those questions asked and their respective answers. Regarding **claims 39, 45, and 51**, the presentation is shown in this embodiment as a video presentation. Regarding **claims 40, 46, and 52**, it is an old and well-known property of a transcript that any action that is taken is recorded in it, therefore having the questions and their answers present and enumerated is also old and well-known. Regarding **claims 41, 47 and 53** two pages overlaid to "form a folder" are shown in 615. Additionally please see figure 7, col. 2 lines 29-31, 35-50, 65- col. 3 line 23, col. 6 lines 21-25, col. 8 lines 48-52, 62- col. 9 line 4 and col. 9 lines 28-37, 40-44, 51-55.

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Sallette does not specifically teach "a second text box for illustrating comments entered by the user during the training session, and for displaying assumptions and information on how to validate the assumptions", as in claims **38, 44, and 50**, or a link to a reference page, as in claims **42, 48, and 54**.

Mortimer teaches a customizable interactive textbook used for the presentation of material in an educational environment. This includes a notes module, which is described in col. 17: 46+ with particular attention to col. 18: 25-29. The use of the notes section including assumptions and information on how to validate the assumptions is equated to col. 18: 43-59. In col. 19: 29-40 a link system is described. This system equates to the reference pages.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Sallette system with the notes module and reference links of Mortimer et al so as to allow a student to write memory jogging notes or look up background information on a topic.

Neither Sallette nor Mortimer specifically teaches the use of a "pop-up" window to enter comments, as in claims **43, 49, and 55**. It is the examiner's position that pop-up windows are an old and well-known method of entering information into a system.

Response to Arguments

9. Applicant's amendments have removed the need for the rejection under 35 USC §112, first paragraph, which was presented in the parent application.

10. Applicant's arguments filed 03/23/2004 have been fully considered but they are not persuasive.

Applicant generally argues that Kerwin fails to teach the limitations of the claimed invention. Specifically the applicant refers to the limitation "allowing the user to enter an assumption that forms the basis for the response and ways to validate the assumption". Applicant then recites a section of the Kerwin patent. Applicant has not shown how this section, other than not using the same terminology, fails to teach the limitation claimed. Absent any direct evidence or arguments explaining the supposed flaws in the examiner's logic, no further comment can be made on the claim at this time.

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Applicant's amendments to claims 18-37, have overcome the previous rejection of these claims in view of the Cook et al reference, for the reason's state on page 13 of the response. However, a new grounds of rejection based upon 35 USC §101 has been presented above. New art has not been applied to these claims, and the content of the claims would be allowable if the applicant overcomes the rejections above.


Applicant's arguments concerning claims 38-55 have been fully considered but are not persuasive. Further upon reconsideration a new grounds of rejections based upon 35 USC §101, has been made regarding claims 38-43. Applicant has argued that Mortimer fails to teach the newly added limitations. The examiner has addressed this limitation in the rejection of the claims above.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kathleen M Christman whose telephone number is (703) 308-6374. The examiner can normally be reached on M-F 8:00-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris Banks can be reached on (703) 308-1745. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Kathleen M Christman
Examiner
Art Unit 3713